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09/750,144	12/29/2000	Steve Lewontin	042933/301045	6775
826	7590	04/18/2008	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			DESAI, RACHNA SINGH	
ART UNIT	PAPER NUMBER			
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STEVE LEWONTIN

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Appeal 2007-4183  
Application 09/750,144  
Technology Center 2100

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Decided: April 18, 2008

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Before ALLEN R. MACDONALD, JAY P. LUCAS, and  
ST. JOHN COURTEMAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

*Introduction*

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

*Prior Art*

Among the prior art relied upon by the Examiner in rejecting the claims on appeal is:

Amano	US 6,003,033	Dec. 14, 1999
Call	US 2002/0143521A1	Oct. 3, 2002
Simon Hunt	US 2004/0049737A1	Mar. 11, 2004

*Rejections*

The Examiner rejected claims 1-3, 5, 7, 10-13, 15, 17, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simon Hunt and Amano.

The Examiner rejected claims 4, 6, 8, 9, 14, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Simon Hunt, Amano, and Call.

*Appellant's Contentions*

Appellant contends that the Examiner erred in rejecting claims 1-21 under 35 U.S.C. § 103(a) because the Simon Hunt reference is not prior art to the claimed invention (App. Br. 4-8).

*Result*

We reverse.

ISSUE

Has Appellant established that the Examiner erred in rejecting claims 1-21 as being unpatentable under 35 U.S.C. § 103(a).

## FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

### *Appellant Application*

1. Appellant's patent application was filed on December 29, 2000.

### *Simon Hunt*

2. The Simon Hunt patent application was filed on October 25, 2002.

3. The Simon Hunt patent application publication claims priority under 35 U.S.C. § 120 to non-provisional U.S. patent applications 09/842,474 and 09/843,036 both filed on April 25, 2001.

4. The Simon Hunt patent application publication also claims priority under 35 U.S.C. § 119(e) to U.S. provisional application 60/199,858 filed on April 26, 2000.

5. The Simon Hunt patent application named as inventors Wallace, Wiatrak, Matlin, Hayosh, McHugh, and Simon Hunt.

6. U.S. provisional application 60/199,858 named as inventors Trapani and Polonsky.

7. The Simon Hunt patent application does not share an inventor with U.S. provisional application 60/199,858.

## PRINCIPLES OF LAW

35 U.S.C. § 119(e)(1) Benefit of earlier filing date; right of priority.

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title,

*by an inventor or inventors named in the provisional application*, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

35 U.S.C 119(e)(1) (emphasis added).

## ANALYSIS

Appellant correctly argues that the Simon Hunt reference is not prior art to the claimed invention (App. Br. 4-8).

The filing dates of the Simon Hunt publication and the 09/842,474 and 09/843,036 U.S. patent applications to which Simon Hunt claims priority are all later than the filing date of Appellant's patent application. (FF 1-3). To qualify as prior art the Simon Hunt publication must be able to legally claim priority to U.S. provisional application 60/199,858 which was filed before Appellant's patent application. (FF 4).

However, the Simon Hunt patent application cannot claim priority to U.S. provisional application 60/199,858, because none of the inventors named on the Simon Hunt patent application are named on U.S. provisional application 60/199,858 as required by 35 U.S.C. § 119(e)(1). (FF 5-7). Thus the Simon Hunt patent application cannot be used as a basis for the rejections indicated above.

CONCLUSIONS OF LAW

- (1) It has been established that the Examiner erred in rejecting claims 1-21 as being unpatentable under 35 U.S.C. § 103(a).
- (2) On this record, claims 1-21 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-21 is reversed.

REVERSED

cc

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